

REMARKS

Claims 1-4 and 6-9 are pending in this application. By this Amendment, claim 1 is amended and claims 2, 7 and 9 are canceled without prejudice or disclaimer. Reconsideration based on the amendments and the following remarks is respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner San Martin in the April 4, 2007 personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

I. The Claims Define Allowable Subject Matter

The Office Action rejects claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over Hess (U.S. Patent No. 1,173,801) in view of Sandler (U.S. Design Patent No. 177,877). The rejection is respectfully traversed.

The Office Action asserts that Hess teaches most of the claimed combination of features, and admits that Hess fails to teach a clamping means composed of a clamping member, separate from the tailpipe, accommodated inside the front-end open portion and sandwiching a periphery of the rear-end open portion of the exhaust pipe. The Office Action asserts that Sandler cures this deficiency by teaching a tailpipe comprising a clamping means being composed of a clamping member, separate from the tailpipe, accommodated inside a front-end open portion sandwiching a periphery of a rear-end open portion of an exhaust pipe at Fig. 1.

Applicants respectfully submit that one of ordinary skill in the art at the time of invention would not have been motivated to combine Hess with the nonenabling Sandler reference. Indeed, the Office Action's reliance upon Sandler to cure the deficiency of Hess exemplifies hindsight reasoning.

The Office Action's assertion that one of ordinary skill in the art at the time of invention would have been motivated to employ Sandler's design because it would provide a

more aesthetical appearance to the tailpipe is erroneous and nonetheless unsupportive of an obvious determination. Specifically, the aesthetical characteristic of the tailpipe is ancillary to the many solutions afforded by the presently claimed combination of features in Applicants' utility application. One of the many advantages afforded by the present application is avoidance of any protruding fastening member or bolt for the clamping means thereby allowing for a construction free of projected portions that would interfere with other parts. One of ordinary skill in the art would not have been motivated by aesthetic appearance to achieve a novel solution to this technical problem.

Moreover, the Hess reference teaches away from seeking such a solution. Specifically, the Hess reference at line 15 states that the invention contemplates a "device which can be readily attached to the exhaust pipe ... and which can be adjusted into position to prevent the exhaust from injuring the extra tire usually carried on the rear end of the machine." It is apparent from this passage that a clamping means construction that was open, readily accessible and free of covering was a necessary element of the invention. Covering this portion, as depicted in Sandler, would be contrary to such an arrangement. Accordingly, Hess teaches away from any alleged solution provided by Sandler.

Even if Sandler could properly be relied upon as a secondary reference, Sandler fails to enable one of ordinary skill in the art at the time of the invention to achieve the solution allegedly taught thereby. Thus, Sandler's disclosure is nonenabling for the purpose of the present rejection. Hess and Sandler, alone or in combination, do not teach or suggest the presently claimed combination of features. Moreover, and as discussed during the personal interview, the claims as amended obviate the rejection.

For reasons including the foregoing, the subject matter of claims 1-9 is distinguishable over Hess and Sandler. Accordingly, withdrawal of the rejection is respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims is earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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